

REMARKS

Claims 1-9 have been examined on their merits, and are all the claims presently pending in the application.

1. Claims 1-9 stand rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Coli *et al.* (U.S. Patent No. 6,018,713). Applicants traverse the rejection of claims 1-9 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Coli *et al.* disclose, *inter alia*, a network-based system that allows medical providers to order medical tests from a variety of medical testing suppliers, monitor the progress of ordered tests, and to receive test results back from a selected medical supplier. *See* Abstract, col. 3, line 1 to col. 8, line 10 of Coli *et al.* The system of Coli *et al.* stores data on medical testing supplier

locations, qualifications and costs to perform tests. *See* col. 12, lines 35-38 of *Coli et al.* Finally, *Coli et al.* disclose that a medical provider communicates with a selected medical testing supplier via the network. *See, e.g.*, Fig. 3 of *Coli et al.*

However, *Coli et al.* fail to teach or suggest a step of at least acquiring a time when a supplier can supply a particular service and making a selection of a supplier based on at least that criteria, as recited in claim 1. In the December 17, 2003 Non-Final Office Action, the Patent Office cites col. 10, lines 53-61 of *Coli et al.* as allegedly teaching this recitation. However, a fair reading of the cited passage does not support the Patent Office's interpretation. The cited passage discloses the ordering of a test or the generation of a test report. There is no disclosure of acquiring a time for when a service can be rendered. Furthermore, at col. 12, lines 29-45 of *Coli et al.*, the selection of suppliers (*e.g.*, medical laboratories) is discussed, but there is no disclosure that the time when a supplier can supply a particular service is considered to be a selection criterion.

In the Final Office Action, the Patent Office asserts that "acquiring supplier information concerning at least a time when each of said suppliers can supply said service via network" is taught or suggested at lines 55-59 of col. 7, lines 43-61 of col. 10, lines 1-29 of col. 13 as well as Figures 2 and 3 of *Coli et al.*

At lines 55-59 of col. 7, Coli *et al.* disclose:

Each of the patient test data records includes a patient ID, test ID, date, observed values, and additional “notes”. The server computer is programmed to transmit a statement document that includes the patient test data records to the client computer.

In the cited text, all that is disclosed is the parameters contained within a test data record of a patient and that a server computer is programmed to transmit a document that contains these parameters. There is no disclosure of at least acquiring a time when a supplier can supply a particular service or making a selection of a supplier based on at least that criteria, as recited in claim 1.

At lines 43-61 of col. 10, Coli *et al.* disclose:

With reference to FIG. 2, a medical test order begins when a physician or other medical professional at hospital computer 202 or physician computer 206 logs onto the network 211. FIG. 3 is a flowchart generally describing the operation of a hospital or physician computer’s test ordering system and test results reporting system, as operable on computers 202 and 206 (shown in FIG. 2). Referring now to FIG. 3, the features of the client software include ordering medical lab tests and generating cumulative results reporting for the tests.

Execution of the client program in FIG. 3 begins with block 300, where the program accepts input from the user to indicate whether the user wishes to order a test, or generate a report. This function is preferably performed by displaying an input screen (see FIG. 4) permitting selection of either test ordering or results reporting functions of the physician interface. The physician can click on button 402 for report generation or button 404 for test ordering (buttons shown in FIG. 4).

In the cited text, all that is disclosed is the logging onto a system to select a lab to order a test or to generate a report. In Figure 3 of Coli *et al.*, step 314 illustrates retrieving the lab options.

Figure 5 of Coli *et al.* shows only a list of medical laboratories available for selection based on health plan participation, cost of tests, medical qualifications and/or location. *See, e.g.*, 510 of Figure 5; col. 12, lines 18-38 of Coli *et al.* Figure 8 of Coli *et al.* illustrates the selection of a medical laboratory from a list of medical laboratories available for selection. There is no disclosure of acquiring at least a time when a supplier (*i.e.*, a medical laboratory) can supply a particular service or selecting a supplier based on at least that criteria, as recited in claim 1.

At lines 1-29 of col. 13, Coli *et al.* disclose:

Once the patient database computer verifies that the originating computer is authorized to request a test, it sends a message to an insurer computer requesting authorization to conduct the test. Upon reading the message at his/her terminal, an insurance claims agent next determines whether the fee for the test is payable under the patient's insurance policy and if it is not, sends a message back to the patient database computer denying payment for the procedure. As shown in FIG. 3, after authorization, the final test order may be transmitted electronically to the lab in block 320, and a written test order, with patient instructions and geographic directions to the lab can be automatically printed and mailed to the patient in block 322. Thus, the system preferably links each physician's office in real time to a plurality of remotely located laboratories, either via a central server or through distributed connections, and provides almost instantaneous communication of test orders and results between physicians and labs. The system receives a selection of the desired tests, and also a diagnosis code associated with the test from the list of codes integrated into the ordering module. The system then automatically identifies for the physician the local laboratories capable of performing the needed tests, checks for HMO or other controlling authorization, permits selection among those laboratories, transmits the test order, and provides printed directions and written confirmation for the patient. Thus, the system provides automated ordering access to multiple labs, in contrast to hospital proprietary terminals which operate only within the hospital.

In the cited text, all that is disclosed is an authorization procedure for a test request that comprises identifying qualified and/or participating medical laboratories, medical insurance coverage and/or required authorizations, test directions and confirmation. Nowhere in the cited text is there any disclosure of acquiring at least a time when a supplier (*i.e.*, a medical laboratory) can supply a particular service or selecting a supplier based on at least that criteria, as recited in claim 1. Furthermore, Coli *et al.*'s alleged disclosure of "real-time" reporting has no bearing on the patentability of claim 1. Claim 1 recites, *inter alia*, "acquiring supplier information concerning at least a time when each of said suppliers *can supply* said service via a network...." (*emphasis added*). Coli *et al.*'s disclosure that a report can be sent in "real-time" or a test request can be distributed in "real-time" is irrelevant, since Coli *et al.* never disclose the selection of a medical laboratory based upon when that laboratory can actually supply a requested service.¹ It is immaterial that the system of Coli *et al.* can transmit a medical report in "real-time" when, in the course of selecting a medical laboratory, the doctor has no ability to select a medical laboratory on the basis of *when* that report will be delivered. In sum, the Patent Office's allegation that Coli *et al.* discloses the acquisition of information of when a supplier can supply a requested service is based on a flawed interpretation of the plain language of claim 1.

To the extent that the Patent Office is making an implicit inherency argument in rejecting claim 1, Applicants remind the Patent Office that the fact that a certain element *may* be present in the prior art is *not* sufficient to establish the inherency of that element. *In re Rijckaert*, 9 F.3d

¹ The use of "real-time" in the disclosure of Coli *et al.* is contrary to how one of ordinary skill in the art understands real-time systems, which are embedded computer systems, not data processing systems.

1531, 1534 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); MPEP § 2112. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). It is abundantly clear from viewing Figures 5-8 of *Coli et al.*, as well as the accompanying text, that supplier selection based on information on when a desired service can be supplied is not inherent in the disclosure of *Coli et al.*

Based on the foregoing reasons, Applicants submit that *Coli et al.* fail to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, *Coli et al.* clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claims 3 and 7 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Examiner withdraw the § 102(a) rejection of claims 1, 3 and 7.

With respect to independent claim 2, Applicants submit that claim 2 is allowable for at least the same reasons discussed above with respect to claim 1, in that *Coli et al.* fail to teach or

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suggest at least a step of acquiring a time when a supplier can supply a particular service and selecting a supplier based on at least that criteria. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 2 is allowable, and further submit that claims 3 and 8 are allowable as well, at least by virtue of their dependency from claim 2. Applicants respectfully request that the Patent Office withdraw the § 102(a) rejection of claims 2, 3 and 8.

With respect to independent claim 4, Applicants submit that claim 4 is allowable for at least the same reasons discussed above with respect to claim 1, in that *Coli et al.* fail to teach or suggest at least a step of acquiring a time when a supplier can supply a particular service and selecting a supplier based on at least that criteria. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 4 is allowable, and further submit that claims 5, 6 and 9 are allowable as well, at least by virtue of their dependency from claim 4. Applicants respectfully request that the Patent Office withdraw the § 102(a) rejection of claims 4-6 and 9.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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